

REMARKS

By this Amendment, claim 24 has been amended to clarify the recited subject matter without any intention of narrowing the scope of any of the claims. Applicants have amended claim 24 in order to expedite prosecution and do not, by this amendment, intend to abandon subject matter of the claims as originally filed or later presented. Moreover, Applicants reserve the right to pursue such subject matter in a continuing application. Claims 1-33 are pending in this patent application. Reconsideration of the rejections in view of the remarks below is requested.

In the Amendment filed April 23, 2004, Applicants intended to amend claim 24 to delete the portion which was substantially included in new claim 33 but, by inadvertence, did not do so. Accordingly, Applicants hereby amend claim 24 to delete the portion of the claim now positively recited in new claim 33. In the Office Action mailed January 23, 2004, the Examiner rejected, *inter alia*, claim 24 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner stated that claim 24 contains the phrase “may be” and that the inclusion of that phrase renders claim 24 indefinite. While Applicants do not agree with the rejection, Applicants also do not believe that alteration of claim 24 in the manner suggested by the Examiner presents a narrowing amendment that might subject the claims to a limited interpretation under the doctrine of equivalents.

In reply to the substance of the Office Action mailed July 28, 2004, Applicants respectfully submit that Applicant’s Amendment filed April 23, 2004 is believed to have been fully responsive to the Office Action mailed January 23, 2004. In any event, Applicants submit that new claims 29-33 are patentable in view of the prior art cited against the pending claims in the Office Action mailed January 23, 2004.

In the Amendment filed April 23, 2004, Applicants discussed that they “amended claims 5, 8, 9, 10, 16, 19, and 21 to delete certain portions objected to by the Examiner and hence broaden the claims.” Further, Applicants submitted that new claims 29-32 “roughly correspond to certain portions deleted from claims 5, 10, 16, and 21.” In essence, the portions deleted from dependent claims 5, 10, 16 and 21 were positively recited in dependent claims 29-32, each of those claims respectively depending from the claim from which the portions were deleted. For example, in claim 5, the text “which may be configured under a secure administration process” was deleted and new claim 29, depending from claim 5, was added

reciting that the scripts “are configured under a secure administration process.” Furthermore, as noted above, claim 24 is now amended to delete the portion of the claim now positively recited in new claim 33, claim 33 depending from claim 24. Thus, each of claims 29-33 find support in the original claims and disclosure of the application.

Further, in the Amendment filed April 23, 2004, Applicants traversed the rejections of claims 1-28 under 35 U.S.C. §102(e) and §103 in view of cited U.S. Patent No. 5,903,882 (“Asay et al.”) and argued for the patentability of independent claims 1 and 12, and all their dependent claims including new claims 29-33. In arguing against the rejections and for the patentability of the pending claims, Applicants submitted that:

“Asay et al. fail to at least disclose an electronic transaction system comprising, *inter alia*, a “reliance server issuing electronic signals representing a signed warranty offer to a relying party” as recited in independent claim 1 and its dependent claims 2-11, 29 and 30 or a method of managing reliance comprising “the relying party bank issuing a signed warranty offer to the relying party” as recited in independent claim 12 and its dependent claims 13-28 and 31-33. In other words, Asay et al. fail to disclose a reliance server making an offer of the warranty to the relying party (which the relying party may accept) instead of simply issuing the warranty to the relying party. An advantage of an offer, among others, is that a relying party could know at the time of the offer the fee it may have to pay for the warranty and then decide whether to accept the offer of the warranty. (See, e.g., page 16, line 15 to page 18, line 4 of the specification.)

Therefore, for at least the above reasons, Asay et al. fail to disclose all the features recited by claims 1-33. Accordingly, Asay et al. cannot anticipate the claims. As a result, Applicants respectfully submit that the rejection under 35 U.S.C. §102(e) should be withdrawn and the claims allowed.

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Therefore, for at least the above reason, Asay et al. is unavailable as prior art under 35 U.S.C. §103(a) against claims 1-33. Thus, Applicants traverse the rejection of claims 9 and 20 and respectfully submit that claims 1-33 are allowable.

In other words, Applicants respectfully submit that the Amendment filed April 23, 2004 was fully responsive at least because the remarks in that Amendment pointed out why the new claims 29-33 are believed to be patentable in view of the prior art cited in the Office Action mailed January 23, 2004.

In any event and for clarification, Applicants submit that new claims 29-33 are patentable in view of the prior art cited in the Office Action mailed January 23, 2004.

Claim 29 is patentable at least because Asay et al. fail to disclose an electronic transaction system comprising, *inter alia*, a “reliance server issuing electronic signals

representing a signed warranty offer to a relying party”, “wherein the reliance server bases a decision to sign the warranty offer on criteria which are defined through scripts” and “wherein the scripts are configured under a secure administration process” as recited in claim 29 (when taking into account claims 1 and 5 from which claim 29 depends).

Claim 30 is patentable at least because Asay et al. fail to disclose an electronic transaction system comprising, *inter alia*, “an authority issuing electronic signals representing subscriber assurance of an attribute of a subscriber to the system” and a “reliance server issuing electronic signals representing a signed warranty offer to a relying party”, “wherein the issuing authority limits a level of warranty” and “wherein the level of warranty is configured to be given for each transaction” as recited in claim 30 (when taking into account claims 1 and 10 from which claim 30 depends).

Claim 31 is patentable at least because Asay et al. fail to disclose a method of managing reliance comprising, *inter alia*, “the relying party bank issuing a signed warranty offer to the relying party”, “wherein the relying party bank bases a decision to sign the warranty offer on criteria which are defined through scripts” and “wherein the scripts are configured under a secure administration process” as recited in claim 31 (when taking into account claims 12 and 16 from which claim 31 depends).

Claim 32 is patentable at least because Asay et al. fail to disclose a method of managing reliance comprising, *inter alia*, “an issuing bank (IB) providing a transaction bearing liability (TBL) certificate to a subscriber”, “the relying party bank issuing a signed warranty offer to the relying party”, “the issuing bank limiting a level of warranty” and “wherein the level of warranty is configured to be given for each transaction” as recited in claim 32 (when taking into account claims 12 and 21 from which claim 32 depends).

Claim 33 is patentable at least because Asay et al. fail to disclose a method of managing reliance comprising, *inter alia*, “the relying party forwarding an assurance request based on the transaction to a relying party bank”, “the relying party bank issuing a signed warranty offer to the relying party”, “the relying party bank verifying that the relying party is authorized to make the request, the verification being based on a relying party’s identity certificate and on attributes determined by the relying party bank” and “wherein the verification based on attributes determined by the relying party bank is based on information requested by the relying party bank from other systems” as recited in claim 33 (when taking into account claims 12 and 24 from which claim 33 depends).

Summarizing with respect to claims 29-33, Asay et al. at least fail to disclose a reliance server making an offer of the warranty to the relying party (which the relying party

may accept) instead of simply issuing the warranty to the relying party. An advantage of an offer, among others, is that a relying party could know at the time of the offer the fee it may have to pay for the warranty and then decide whether to accept the offer of the warranty. (See, e.g., page 16, line 15 to page 18, line 4 of the specification.)

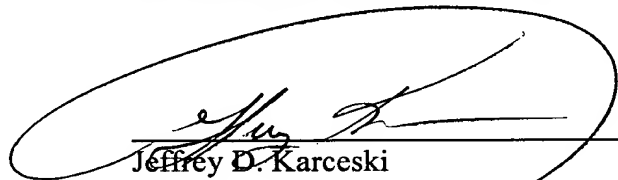
Further, as argued in detail in the Amendment filed April 23, 2004, Asay et al. is unavailable as prior art under 35 U.S.C. §103(a) against the pending claims, including new claims 29-33.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance. If questions relating to patentability remain, the examiner is invited to contact the undersigned to discuss them.

Should any fees be due, please charge them to our deposit account no. 03-3975, under our order no. 061047/0265648. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced deposit account.

Respectfully submitted,

PILLSBURY WINTHROP LLP

A handwritten signature in black ink, appearing to read "Jeffrey D. Karceski", is written over a horizontal line. The signature is enclosed within a large, hand-drawn oval.

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